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REMARKS

The Examiner indicated that the Office Action is final, yet he cited new references (Mills, Oatley et al., and DePalma) and new grounds for rejection. According to MPEP § 706.07(a),

Under present practice, second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims* nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. 1.97(c). . . .(emphasis added)

Every claim element mentioned by the Examiner in his rejection of claims 16, 6, 7, and 10 was present in the claims as filed and in new claim 16. Thus, these new grounds for rejection were not necessitated by any amendments to the claims. Also, Applicant did not file an additional information disclosure statement under 37 C.F.R. § 1.97(c). Therefore, it is improper that the Office Action dated January 12, 2006, was made final.

Accordingly, this response is being submitted with additional arguments on the merits of the claims. Reconsideration and further examination is respectfully requested.

Claims 16 and 17 have been amended to clarify and emphasize that the feminine hygiene article is formed for retention *by and between the user's buttocks*. This language was included in original claims 1 and 14, and there are numerous statements in the written description that clearly indicate that the device is retained by and between the user's buttocks. No new matter has been added by these amendments. Support for the amendments can be found in original claims 1 and 14.

Claims 2-5, 8, 9, 11, and 15-17 stand rejected under 35 U.S.C. § 102(b) as being

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anticipated by Sturino (U.S. Patent No. 5,713,886). In making this rejection, The Examiner stated:

Regarding claim 16, Sturino teaches a feminine hygiene article (10) for absorption of bodily fluids, comprising:

... wherein said back end (18) is capable of retention between a user's buttocks ... without causing significant discomfort ...

Amended claims 16 and 17 now recite that the back end of the feminine hygiene article is formed for retention *by and between a user's buttocks without causing significant discomfort*.

The Sturino panty liner includes a removable release liner 48 covering an adhesive layer 36 on the end portion 18 of the liner. The adhesive layer is for adhering the panty liner to a pair of panties. Thus, the Sturino panty liner is *not formed for retention by and between a user's buttocks*. The Sturino patent does not identically disclose every feature in the pending claims 2-5, 8, 9, 11, and 15-17. Therefore, rejection of these claims under § 102(b) is improper and should be withdrawn.

Further, if used without being adhered to the user's panty, the Sturino device would most likely be quite *uncomfortable*. The removable release liner, if kept in place, would most likely be stiff and perhaps slippery, thus interfering with comfortable retention by and between the user's buttocks as recited in claims 16 and 17. The edges of the release liner could also be irritating to the user's skin. If the release liner were removed, it is likely that adhesive would contact the skin of the user's buttocks and cause discomfort and perhaps skin irritation; the adhesive is intended for adherence to the user's panty, not the user's skin.

Claims 16, 6, and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mills

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(US 3,143,113). The Examiner stated that the sanitary napkin of Mills has a back end having a folded width sufficiently small to be capable of fitting between the user's buttocks and legs without causing significant discomfort.

Claim 16 recites that the feminine hygiene article is *formed for retention by and between a user's buttocks* and has a *width sufficiently small to fit between the user's buttocks without causing significant discomfort*.

Mills teaches the use of a multiplicity of plies of webs in face-to-face contact, with the plane of each ply perpendicular to the planes of the upper and lower faces of the napkin (Col. 2, lines 39-46). The laminated inner portion is described as being 1/4 to 1/2 inch thick or deep. In contrast to Applicant's feminine hygiene article, the sanitary napkin of Mills is relatively *bulky*, and it is *not formed for retention by and between the user's buttocks*. Because the laminated layers of the Mills napkin are stacked with the faces perpendicular to the upper and lower faces of the napkin and enclosed in an outer wrap, the napkin would be *stiff and difficult to crease or fold longitudinally*.

With respect to claims 6 and 7, the Examiner stated that *Mills* teaches that the article comprises a layer (15a) rolled into an elongated coil. The Examiner further stated that *White* teaches a device that would be subjected to creasing and twisting forces while being used by a wearer (emphasis added).

Claim 6 recites that the *article* is rolled into an elongated coil, and claim 7, which depends from claim 6 also is directed to an article that is rolled into an elongated coil. It is well established that claim language is to be interpreted based on the specification. As described in the written description and the drawings, *the direction of elongation of the coil of Applicant's*

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invention is substantially parallel to the axis about which the sheet or sheets are coiled.

In contrast, the embodiment of Figs. 3 and 4 of Mills *includes* a coil, formed by a slice of an hollow annular roll of material, with the slice *elongated in a direction running perpendicular to the axis about which the roll is formed*. The coil is placed atop an absorbent layer (Col. 3, lines 51-55).

Thus, the Mills article is *not an elongated coil* in the same sense as the term “elongated coil” is used in the pending application. Mills does not identically disclose Applicant’s invention, and the rejection under 35 U.S.C. § 102(b) is improper and should be withdrawn.

With respect to claim 7, the rejection under § 102(b) was stated to be on the basis of anticipation by Mills, not White. Assuming that the Examiner meant to say “Mills” instead of “White,” the rejection is improper as explained above regarding claim 6, because claim 7 depends from claim 6 and includes the same type of elongated coil as claim 6.

If the Examiner meant to reject the claim as anticipated by White, that rejection is also improper. 35 U.S.C. § 102 states,

A person shall be entitled to a patent unless--

...

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the date of the application for patent in the United States, . . .

The White patent application was published on March 18, 2004, and the patent issued on May 10, 2005. Applicant filed her application on September 24, 2003, well before the publication of the White patent application and issuance of the White patent. Therefore, any rejection of claims in the pending application under §102(b) as anticipated by White is improper and should be withdrawn.

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Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills. The Examiner stated: "Mills teaches that the device has a depth, height or thickness between 1/4 and 1/2 inches."

Claim 10 includes the limitations of claim 16 and further recites that the feminine hygiene article of the pending application has a height between about 0.5 and about 1.5 inches.

Mills device is *not formed for retention by and between a user's buttocks*, but rather to be placed next to the user's body (claim 1). At the time the Mills application was filed, in 1962, the term "sanitary napkin" referred to a relatively bulky object that was held in place adjacent the wearer's crotch, such as by securing the ends to a special belt. Clearly, this was the method of use intended by Mills, as discussed in Col. 2, lines 8-13, with the outer wrap extending beyond the ends of the absorbent part of the pad.

If the Mills device were folded and inserted between the user's buttocks, it would be bulky and uncomfortable, because the folded thickness would be too great for comfortable retention between the user's buttocks. Indeed, the discomfort associated with the 1960-era sanitary napkins, which were pulled against the wearer's crotch by the tension of the belt and felt as if one had a large wad of material between one's legs, was one of the major reasons why the older sanitary napkins have been replaced by more comfortable pads that adhere to the user's panties and are not held tightly against the user's crotch. However, even the thicker pads that adhere to panties are uncomfortable. Applicant's invention solves this problem of discomfort.

Further, *folding the Mills device* for retention by and between the user's buttocks *would defeat the function of the device*, i.e., to provide spaces between the absorbent plies to direct menstrual flow toward the ends of the napkin (Col. 3, lines 1-10). If the Mills device were forced

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between the user's buttocks, the plies would be compressed, thereby becoming less absorbent, and also the spaces between the plies would be compressed, restricting fluid flow through the spaces.

Therefore, it would not have been obvious to one skilled in the art at the time of the present invention to make an article like the Mills sanitary napkin for retention by and between a user's buttocks. This holds true, regardless of any possible overlap of thickness ranges between the teaching of Mills and claim 10 of the pending application.

Claims 1, 6, and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over White (U.S. Patent No. 6,890,326 B2) and Pierce *et al.* (U.S. Patent No. 4,340,058). Claim 1 was previously canceled.

As was previously pointed out, the White application was filed on September 12, 2002, and published on March 18, 2004. Thus, the White publication date is more than five months after the filing date of the present invention, September 30, 2003. Further, Applicant's invention was completed prior to the filing date of White. Applicant previously submitted a Declaration under 37 C.F.R. § 1.131. A copy of that Declaration is attached, along with copies of pages 6-9, 14-19, and several following unnumbered pages from a bound notebook describing embodiments of the invention and a description of results from experimental use of the invention that occurred prior to June 19, 2002.

Therefore, the White publication is not prior art with respect to the pending application. The rejection of claims 6 and 7 is improper and should be withdrawn.

Applicants believe that all pending claims are in condition for allowance, and such action

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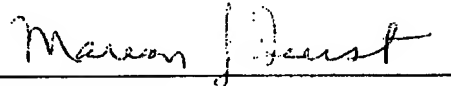
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is earnestly solicited. It is believed that no additional fees are due with this amendment.

However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Marian J. Furst, Applicant's Attorney, at 801-967-5433 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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